

II. Claims 28-37, drawn to a method of making a water vapour barrier, classified in class 428, subclass 219.

In response to the Examiner's restriction/election requirement, Applicant elects, with traverse, to prosecute Group I, to which claims 1-27 are directed. Applicant specifically reserves the right to file a divisional application directed to non-elected claims 28-37.

Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (PCT Article 3(4)(iii) and 17(3)(a), PCT Rule 3.1, and 37 CFR 1.475). Observance of this requirement is checked by the International Searching Authority and may be relevant in the national (or regional) phase.

The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of 37 CFR 1.141(b)(2) as applied to unity of invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression "specifically designed" as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

Therefore, when the USPTO considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the

national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111.

In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.

PCT Rule 13.2 includes a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Annex B of the Administrative Instructions contains examples concerning unity of invention.

Applicant respectfully submits that the "special technical feature" which is present in both independent claims 1 and 28 is a membrane material having "a water vapour diffusion resistance, which varies with the relative moisture of air in contact therewith."

Further, International Preliminary Examination Report of April 2, 2001, clearly indicated that unity of invention was present in connection with the present application.

Applicant respectfully submits that as a result of the fact that the present application is a national phase entry of a PCT application, PCT rules 13.1 and 13.2 should be applied, instead of the conventional restriction rules for direct U.S. application filings.

Applicant respectfully submits that claims 1-37 of the present application are directed to the same invention, as set forth in PCT Rule 13.1 and 13.2, and as found by the European Examiner.

For all of the above stated reasons, reconsideration and withdrawal of the outstanding restriction/election requirement and favorable allowance of all claims in the instant application are earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

HARNESS, DICKEY & PIERCE, PLC

By



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